

REMARKS

As a preliminary matter, Applicants thank the Examiner for the courtesy extended to Applicants' representative during a telephone conference on March 15, 2005. During the telephone conference, Applicants' representative noted that the form 1449 filed with the December 14, 2001, Information Disclosure Statement has not yet been returned to the Applicants. The Examiner noted the Statement in his file and stated that we would return the 1449 in due course. Applicants therefore request its prompt return to document the Examiner's consideration of the cited references.

In the Final Office Action, the Examiner rejected all of the pending claims under 35 U.S.C. § 102(b) as being anticipated by *Fukushima et al.*, U.S. Patent No. 5,799,289. By this Amendment, Applicants have amended claims 1, 11, and 27 to point out aspects of the present invention. Applicants have also amended claim 18 to correct a typographical error and cancelled claims 32-34 without prejudice or disclaimer of the subject matter contained therein. Finally, Applicants have added new claims 35-37, taking care not to add new matter. Therefore, claims 1, 3-31, and 35-37 are currently pending.

To anticipate a claim, the reference must teach every element of the claim. M.P.E.P. § 2131.01 (8th ed. 2001, 2nd revision May 2004). *Fukushima et al.* fails to disclose several elements of the pending claims, and Applicants accordingly request the continued examination and withdrawal of the section 102 rejections of claims 1, 3-31, and 35-37.

Claim 1, as amended, recites a method including the step of establishing a plurality of supplier classes, each supplier class corresponding to a supplier selection

guideline to be used when a member of the supplier class is considered for selection.

Fukushima et al. does not teach such a method. Instead, the reference discloses an order management system including a supplier master file that stores supplier information including an order prohibition flag 81e. (*Fukushima et al.*, col. 5, ll. 30-36.) According to the reference, “[t]he order prohibition flag 81e indicates that an order is prohibited for a predetermined period.” (*Id.*, col. 5, ll. 33-37.) In the Final Office Action, the Examiner alleged that this prohibition flag “represents supplier classes as well as making a supplier determination based on the supplier classes.” (January 11, 2005, Office Action, p. 3.) By its very nature, a flag, such as the prohibition flag of *Fukushima et al.*, has two settings: it is either set or not. Applicants respectfully disagree with the notion that a flag can somehow teach both the step of establishing supplier classes and the step of making a supplier determination based on the supplier classes.

However, to further clarify aspects of the invention, Applicants have amended claim 1 to recite the step of establishing a plurality of supplier classes, each supplier class corresponding to a supplier selection guideline to be used when a member of the supplier class is considered. The reference clearly contains no teaching of a supplier selection guideline corresponding to the prohibition flag, even if the prohibition flag could be interpreted as disclosing a plurality of supplier classes. Furthermore, the reference does not disclose a supplier selection guideline to be used when a member of the supplier class is considered.

Amended claim 1 also recites the step of applying the corresponding supplier selection guideline for each supplier class represented in a plurality of potential suppliers. Because *Fukushima et al.* does not disclose a supplier class corresponding

to a supplier selection guideline, it also does not disclose applying the corresponding supplier selection guideline for each supplier class represented in a plurality of potential suppliers.

Therefore, *Fukushima et al.* fails to teach every element of amended claim 1, and Applicants request the reconsideration and withdrawal of the rejection of claim 1.

Claims 3-17 depend from claim 1 and indirectly contain its recitations. Thus, *Fukushima et al.* fails to teach every element of claims 3-17 at least by virtue of their dependence from claim 1, and Applicants request the reconsideration and withdrawal of the rejections of claims 3-17.

Claim 18 recites a method including the steps of determining a documentation amount in response to selection guidelines and a comparison and documenting at least one characteristic of a supplier selection process in response to said document amount. In the Final Office Action, the Examiner noted that *Fukushima et al.* includes a facsimile edit unit for editing order information and argued that “facsimile information represents documentation. In addition as every transaction requires documentation, it is inherent that the documentation amount exists and it equals zero. Greater than zero the process is documented less than or equal to zero nothing happens.” (January 11, 2005 Office Action, p. 3.)

First, Applicants respectfully disagree with the assertion that the facsimile information of *Fukushima et al.* discloses the step of documenting at least one characteristic of a supplier selection process in response to said document amount. The reference plainly states that “facsimile edit unit 79 is provided for editing the order information...to obtain image information for facsimile transmission.” (*Fukushima et al.*,

col. 5, ll. 9-11.) The order information includes “a supplier’s name, an item name or number and the number of pieces to be ordered.” (*Id.*, col. 4, ll. 33-34.) In other words, the order information that may be edited using the facsimile edit unit of the reference includes a supplier’s name. Thus, any editing performed by the facsimile unit would be unrelated to a characteristic of a supplier selection process, as recited in claim 18.

Further, the Examiner has not shown a teaching in the reference of the step of determining a documentation amount in response to selection guidelines and a comparison. Instead, the Office Action contains generalized statements regarding every transaction requiring documentation and a documentation amount that equals zero, is greater than zero, or is less than zero without any evidence to support them beyond the Examiner’s claim that “it is inherent.” To rely on an inherent characteristic to fill a gap in a reference requires extrinsic evidence that “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” M.P.E.P. § 2131.01 (8th ed. 2001, 2nd revision May 2004). Applicants submit that the Examiner has not shown any such evidence to support a rejection based on inherent matter. Furthermore, even if the Examiner does mean to rely on inherency, it is unclear exactly what the Examiner is arguing is inherent that would teach the step of determining a documentation amount in response to selection guidelines and a comparison.

Because the Examiner has not shown a teaching of every element of claim 18, Applicants request the reconsideration and withdrawal of the rejection of the claim. Claims 19-26 depend from claim 18 and indirectly contain its recitations. Thus, the

Examiner has not shown a teaching of every element of claim of claims 19-26, and Applicants request the reconsideration and withdrawal of the rejections of claims 19-26.

Amended claim 27 recites an apparatus including a monitoring system configured to establish a plurality of supplier classes, each supplier class corresponding to a supplier selection guideline to be used when a member of the supplier class is considered for selection. Claim 27 further recites that the monitoring system is configured to apply the supplier selection guideline corresponding to each supplier class represented in a plurality of suppliers. For reasons set forth above with respect to claim 1, *Fukushima et al.* does not disclose such a structure. Because the cited reference does not teach every element of claim 27, Applicants request the reconsideration and withdrawal of the section 102 rejection of the claim. Claims 28-31 depend from claim 27 and indirectly contain its recitations. Thus, *Fukushima et al.* fails to teach every element of claims 28-31 at least by virtue of their dependence from claim 27, and Applicants request the reconsideration and withdrawal of the rejections of claims 28-31.

New claims 35-37 recite, either directly or indirectly, establishing a plurality of supplier classes, each supplier class corresponding to a supplier selection requirement to be used when a member of the supplier class is considered for selection; categorizing a plurality of potential suppliers according to the supplier classes; and, for a supplier class represented in the plurality of potential sponsors, applying the corresponding supplier selection requirement when selecting a supplier from the plurality of potential suppliers. At least because *Fukushima et al.* does not teach these claim elements, claims 35-37 are allowable over the reference. Thus, Applicants request the examination and allowance of new claims 35-37.

PATENT
Customer No. 22,852
Attorney Docket No. 08350.1753

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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